

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**

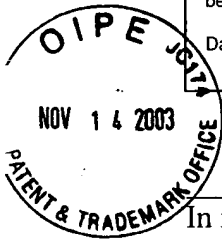
4.1

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, facsimile no. (703) 872-9310, on the date shown below.

Dated: 11/14/03 Signature: Nancy DeRiggi
Nancy DeRiggi

RECEIVED
NOV 20 2003
TC 1700

Docket No.: 163852016000
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takeshi KAKINUMA et al.

Application No.: 09/095,365

Art Unit: 1734

Filed: June 10, 1998

Examiner: L. Gray

For: SHEET SORTING APPARATUS

COMMUNICATION TO EXAMINER

MS Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants are submitting a duplicate copy of the Amendment Under 37 CFR 1.111 originally filed November 12, 2003 by facsimile. Because no fax receipt was received from the U.S. Patent and Trademark Office, Applicants have no way of knowing that the Amendment has been made of record.

Enclosed is a copy of the original Amendment as filed by facsimile, including the verification of fax transmission dated November 12, 2003. Please make the Amendment Under CFR 1.111 of record on November 12, 2003 in the application.

Dated: November 14, 2003

Respectfully submitted,

By Deborah S. Gladstein
Deborah S. Gladstein
Registration No.: 43,636
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7753

MORRISON & FOERSTER

JOB #428

DATE	TIME	TO/FROM	MODE	MIN/SEC	PGS	STATUS
001 11/12	3:18P	85#2016000#7038729310	EC--S	03' 16"	009	OK L1

FAX TRANSMISSION

DATE: November 12, 2003

PTO IDENTIFIER: Application Number 09/095,365

Patent Number

Inventor: Takeshi KAKINUMA et al.

MESSAGE TO: Linda Lamey Gray, GAU 1734; U.S. Patent and Trademark Office

FAX NUMBER: (703) 872-9310

FROM: MORRISON & FOERSTER LLP

Deborah S. Gladstein

PHONE: (703) 760-7753

Attorney Dkt. #: 163852016000

PAGES (Including Cover Sheet): 9

CONTENTS: AMENDMENT UNDER 37 CFR 1.111 (7 pages) and
Certificate of Transmission under 37 CFR 1.8 (1 page).

If your receipt of this transmission is in error, please notify this firm immediately by collect call to sender at (703) 760-7753 and send the original transmission to us by return mail at the address below.

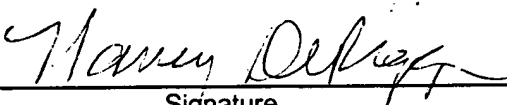
This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution or duplication of this transmission by someone other than the intended addressee or its designated agent is strictly prohibited.

MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300, McLean, Virginia 22102
Telephone: (703) 760-7700 Facsimile: (703) 760-7777

Certificate of Transmission Under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States
Patent and Trademark Office

on November 12, 2003
Date


Signature

Nancy DeRiggi
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate
must identify each submitted paper.

AMENDMENT UNDER 37 CFR 1.111 (7 pages). and
Certificate of Transmission under 37 CFR 1.8 (1 page).

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, facsimile no. (703) 872-9310, on the date shown below.

Dated: 11/12/03

Signature: Nancy DeRiggi

Nancy DeRiggi

Docket No.: 163852016000
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Free Patent Application of:
Takeshi KAKINUMA et al.

Application No.: 09/095,365

Art Unit: 1734

Filed: June 10, 1998

Examiner: L. Gray

For: SHEET SORTING APPARATUS

AMENDMENT UNDER 37 CFR 1.111

MS Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

This is in response to the non-final Office Action dated August 14, 2003.

Reconsideration and allowance of the pending claims, as amended, in light of the remarks presented herein are respectfully requested.

Amendments to the Claims are reflected in the listing of claims which begins on page 4 of this paper.

Remarks/Arguments begin on page 5 of this paper.

AMENDMENTS TO THE CLAIMS

Claim 1 (currently amended). A sheet sorting apparatus for adhering a marker to each predetermined sheet of a group of sheets being output by an image processing apparatus, comprising:

a tape feeder for pulling out a tape, whose width is smaller than that of said sheets, having a pressure sensitive adhesive on one side edge;

a cutter for making the marker by cutting the tape at a preset length;

a guide for positioning the marker at a predetermined position on the predetermined sheet;

and

a marker and sheet feeder for synchronously feeding the marker and the predetermined sheet in a partially overlapping position,

wherein the marker and sheet feeder are formed as a pair of feeding means for positioning in contact with each other when the marker is adhered to the predetermined sheet, and separate from each other when sheets not receiving a marker are fed, and

the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder without pausing the marker and sheet feeder, with one portion of the marker overlapping and in contact with the predetermined sheet and remainder of the marker protruding from the predetermined sheet to indicate a boundary between a sheet or group of sheets and a subsequent sheet or group of sheets.

Claim 2 (previously presented). The sheet sorting apparatus according to claim 1, wherein said marker is adhered to the under side of the sheet.

Claim 3 (previously presented). The sheet sorting apparatus according to claim 1 or 2, further comprising:

a character mark printer for applying a predetermined color pattern or character to the marker; and

a printer controller for determining the character or pattern to print on the marker, so that the same character or pattern is printed on each said marker in a group of said sheets.

Claim 4 (previously presented). The sheet sorting apparatus according to claim 1, further comprising means for changing the adhering position of the marker on the sheet.

Claim 5 (previously presented). The sheet sorting apparatus according to claim 1, further comprising a marker detector in a forward position of the sheet sorting apparatus.

Claim 6 (previously presented). The sheet sorting apparatus according to claim 1, further comprising a tape end detector on the path of the tape for signaling an exchange of the tape.

Claim 7 (original). The sheet sorting apparatus according to claim 1, further comprising a single motor for driving the tape feeder, the cutter, the guide and the marker and sheet feeder.

Claim 8 (original). The sheet sorting apparatus according to claim 1, wherein the tape feeder, the cutter, the guide and the marker and sheet feeder are driven by an external motor.

Claim 9 (original). The sheet sorting apparatus according to claim 3, wherein the character mark printer is an inkjet printer for applying the predetermined color pattern to the marker.

Claim 10 (original). The sheet sorting apparatus according to claim 3, wherein the character mark printer is a stamper for applying the predetermined character to the marker.

Claim 11 (canceled)

Claim 12 (Currently amended). An image processing apparatus comprising a sheet sorting apparatus for adhering a marker to each predetermined sheet of a group of sheets discharged from the image processing apparatus, the sheet sorting apparatus comprising:

a tape feeder for pulling out a tape, whose width is smaller than that of said sheets, having a pressure sensitive adhesive on one side edge;

a guide for positioning the marker at a predetermined position on the predetermined sheet;
and

a marker and sheet feeder for synchronously feeding the marker and the predetermined sheet in a partially overlapping position,

wherein the marker and sheet feeder are formed as a pair of feeding means for positioning in contact with each other when the marker is adhered to the predetermined sheet and separate from each other when sheets not receiving a marker are fed, and

the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder without pausing the marker and sheet feeder, with one portion of the marker overlapping and in contact with the predetermined sheet and the remainder of the marker protruding from the predetermined sheet to indicate a boundary between a sheet or group of sheets and a subsequent sheet or group of sheets.

Claim 13 (original). The image processing apparatus according to claim 12, further comprising a tray for receiving sheets being output by the image processing apparatus, wherein at least one side of the tray is lower than the middle part of the tray.

Claim 14 (previously presented). A sheet sorting apparatus according to claim 1, wherein the exchange of the position of the feeding means is operated synchronously with the operation of the cutter.

REMARKS

Claims 1-10 and 12-14 are pending. Claims 1 and 12 have been amended. No new matter has been added.

Claims 1, 2, 5 and 14 were rejected under 365 USC 102(e) as being anticipated by Norman, U.S. Patent 5,807,457. This rejection is respectfully overcome.

Claim 1 has been amended to clarify that the wide of the tape is smaller than the width of the sheets onto which the tape is adhered. Further, claim 1 has been amended to clarify that “the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder without pausing the marker and sheet feeder, with one portion of the marker overlapping and in contact with the predetermined sheet and remainder of the marker protruding from the predetermined sheet to indicate a boundary between a sheet or group of sheets and a subsequent sheet or group of sheets.” According to that which is recited in claim 1, the boundary indicated by the marker is easily detected by the person who divides the sheets into different groups. Norman does not teach or suggest this feature.

Norman discloses that a group of checks, each check having a tape whose length is the same as the length of the check, are carried to the stack 130 in one mode, and in another group of checks without any tape is carried to the stack 130 in another mode. As can be seen in Fig. 1, the strip 26 and the check 22 are the same width. In other words, the strip will not overlap the check and will not be an adequate boundary between the checks such that it would be easily detectable to a person dividing the checks. Accordingly, the features of claim 1 are not taught or suggested by Norman.

Claims 2, 5 and 14 are allowable at least due to their respective dependencies. Applicants respectfully request that this rejection be withdrawn.

Claims 3, 9 and 10 were rejected under 35 USC 103(a) as being unpatentable over Norman in view of Cavender, U.S. Patent 4,070,220. This rejection is respectfully traversed.

Claims 3, 9 and 10 depend from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Cavender also fails to teach or suggest these features, and is not being relied upon as such, these claims are allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claim 4 was rejected under 35 USC 103(a) as being unpatentable over Norman in view of Lowe, U.S. Patent 3,926,713. This rejection is respectfully traversed.

Claim 4 depends from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Lowe also fails to teach or suggest these features, and is not being relied upon as such, claim 4 is allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claim 6 was rejected under 35 USC 103(a) as being unpatentable over Norman in view of Nobile, U.S. Patent 5,390,594. This rejection is respectfully traversed.

Claim 6 depends from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Nobile also fails to teach or suggest these features, and is not being relied upon as such, claim 6 is allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claims 7 and 8 were rejected under 35 USC 103(a) as being unpatentable over Norman in view of Nobile. This rejection is respectfully traversed.

Claims 7 and 8 depend from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Nobile also fails to teach or suggest these features, and is not being relied upon as such, these claims are allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claims 12 and 13 were rejected under 35 USC 103(a) as being unpatentable over Norman in view of Applicants' admitted prior art. This rejection is respectfully traversed.

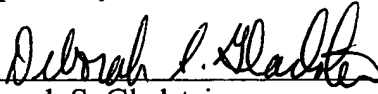
Claim 12 recites the same features discussed above in connection with claim 1. Norman fails to teach or suggest these features. The Applicants' admitted prior art also fails to disclose or suggest these features. Thus, claim 12 is allowable for the same reason claim 1 is allowable. Claim 13 is allowable at least due to its dependency from claim 12. Applicants respectfully request that this rejection be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 163852016000.

Dated: November 12, 2003

Respectfully submitted,

By 
Deborah S. Gladstein

Registration No.: 43,636
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7753